



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,833	12/17/2001	David John Heal	BBC-180	1200

7590 .. 10/23/2003

GAYLE B. O'BRIEN
ABBOTT BIORESEARCH CENTER
100 RESEARCH DRIVE
WORCESTER, MA 01605-4314

EXAMINER

HENLEY III, RAYMOND J

ART UNIT	PAPER NUMBER
----------	--------------

1614

DATE MAILED: 10/23/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,833

Applicant(s)

HEAL, DAVID JOHN

Examiner

Raymond J. Henley III

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

CLAIMS 1-3, 7 AND 8 ARE PRESENTED FOR EXAMINATION

Applicant's Amendment and Information Disclosure Statement filed April 17, 2002 have been received and entered into the application. Accordingly, claims 4-6 have been canceled. Also, as reflected by the attached, completed copies of Form PTO-1449, (6 pages) the cited references have been considered.

In light of applicant's amendment and the declaration of John Heal under 37 CFR 1.132, the rejection under 35 U.S.C. 103 of claim 8 is withdrawn insofar as unexpected results have been established for the composition as claimed.

Withdrawal of Final Rejection

Because the Examiner, in light of applicant's response at page 5, second paragraph, has just become of U.S. Patent No. 6,403,641 which has a common assignee with and a different inventive entity than the present application, the finality of the rejection dated November 13, 2002 is withdrawn. New rejections based upon this reference appear below.

Claim Rejection - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is indefinite because does not contain a graphical representation of "Formula 1" and thus is incomplete.

Claim Rejection - 35 USC § 103

Claims 1-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buttle (Exp. Opin. Invest. Drugs (1996), 5(12):1583-1587) and Wilding (BMJ Volume 315, 18 October 1997, pp 997-1000), each of record, for the reasons of record as set forth in the previous Office action dated November 13, 2002 as applied to claims 1-8.

The Examiner newly notes that claim 7 reads on the manufacture of a medicament containing a compound of formula 1 as “defined” in claim 7. The references relied upon do not teach manufacturing method for a medicament containing such compound, however, because the only step required by claim 7 is the step of incorporation, such is deemed to have been obvious because such a step would have been recognized as being essential and well known to the manufacture of any medicament.

Applicant’s response and the Declaration of David Heal have been carefully considered, but fail to persuade the Examiner of error in his determination of obviousness. The present claims are directed to the treatment of co-morbid conditions associated with obesity rather than obesity itself. Applicant’s remarks and the declaration of Mr. Heal are directed to the treatment of obesity itself and in neither applicant’s remarks or the declaration of Mr. Heal is there provided the necessary nexus between the showing of Mr. Heal to presently claimed subject matter.

Accordingly, the Examiner deems the claims to remain properly rejected.

Claim Rejection - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1614

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Heal et al. (U.S. Patent No. 6,403,641) who teaches the claimed composition/product at col. 9, line 1 – col. 10, line 16.

The applied reference has a common applicant and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Double Patenting

Statutory

Claim 8 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 5 and 6 of prior U.S. Patent No. 6,403,641 (Heal et al.). This is a double patenting rejection.

Claim 8 is directed to the same invention as that of claims 4 and 5 of commonly assigned U.S. Patent No. 6,403,641 (Heal et al.). The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more

Art Unit: 1614

than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Obviousness-Type

Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,403,641. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are directed to the treatment of co-morbid conditions associated with obesity, while the patented claims are directed to the treatment of obesity, *per se*, in which the same combination of active agents are employed.

The presently claimed subject matter would have been obvious because the patented claims teach the treatment of obesity and as such, it is believed that the skilled artisan would have readily recognized that the pathophysiological sequela of obesity would also be effectively treated.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

Art Unit: 1614

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).


A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ray Henley whose telephone number is 703-308-4652. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 703-308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Raymond J. Henley III
Primary Examiner
Art Unit 1614

Rjh
October 7, 2003